UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER FOR PATENTS
P.O. Box 1450
Alexandria, Virginia 22313-1450
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/747,623	12/30/2003	Noel Enete	06975-388001	2832

26171 7590 03/13/2007
FISH & RICHARDSON P.C.
P.O. BOX 1022
MINNEAPOLIS, MN 55440-1022

EXAMINER	
ALVESTEFFER, STEPHEN D	
ART UNIT	**PAPER NUMBER**
2173	

SHORTENED STATUTORY PERIOD OF RESPONSE	MAIL DATE	DELIVERY MODE
3 MONTHS	03/13/2007	PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

If NO period for reply is specified above, the maximum statutory period will apply and will expire 6 MONTHS from the mailing date of this communication.

Office Action Summary	Application No.	Applicant(s)	
	10/747,623	ENETE ET AL.	
	Examiner	Art Unit	
	Stephen Alvesteffer	2173	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☒ Responsive to communication(s) filed on *12 May 2004 and 30 December 2003*.

2a)☐ This action is **FINAL**. 2b)☒ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) *1-52* is/are pending in the application.

4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) *1-52* is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.

10)☒ The drawing(s) filed on *30 December 2003* is/are: a)☒ accepted or b)☐ objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12)☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a)☐ All b)☐ Some * c)☐ None of:

1.☐ Certified copies of the priority documents have been received.

2.☐ Certified copies of the priority documents have been received in Application No. _____.

3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1) ☒ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☒ Information Disclosure Statement(s) (PTO/SB/08) Paper No(s)/Mail Date *20040512*.
4) ☐ Interview Summary (PTO-413) Paper No(s)/Mail Date. _____.
5) ☐ Notice of Informal Patent Application
6) ☐ Other: _____.

DETAILED ACTION

Claims 1-52 are presented for examination. Claims 1, 26, 27, and 52 are independent claims. The information disclosure statement filed on May 12, 2004 has been considered by the examiner.

Double Patenting

The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. A nonstatutory obviousness-type double patenting rejection is appropriate where the conflicting claims are not identical, but at least one examined application claim is not patentably distinct from the reference claim(s) because the examined application claim is either anticipated by, or would have been obvious over, the reference claim(s). See, e.g., *In re Berg*, 140 F.3d 1428, 46 USPQ2d 1226 (Fed. Cir. 1998); *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) or 1.321(d) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent either is shown to be commonly owned with this application, or claims an invention made as a result of activities undertaken within the scope of a joint research agreement.

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

Claims 1, 4-5, 7, 9-16, and 19 are provisionally rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claims 1-2, 4, 7, 12-19, and 21 of copending Application No. 10/334,129 (hereinafter '129). Although the conflicting claims are not identical, they are not patentably distinct from each other because '129 recites the same limitations as the instant application but is

broader in scope. Application '129 recites a computer implemented method for enabling perception of a personalization item in an instant messaging communications session. A personalization item is defined in the specification as sometimes taking the form of a video segment (see '129 specification page 3, lines 6-9), which is the same as the video clip recited in the instant application. It should also be noted that "one or more still photographs and a sound track" of the instant application is equivalent to a "video segment" in '129. Below is a comparison of the claims showing the limitations subject to double patenting:

Instant Application	**10/334,129**
1. A computer implemented method for enabling perception of a video clip in an instant messaging communications session, the method comprising: storing on a host system one or more video clips; receiving a request at the host system for a selected video clip to be delivered to an instant messaging participant system; accessing the selected video clip stored at the host system; and communicating the selected video clip from the host system to the instant messaging participant system for rendering in an instant messaging application running on the instant messaging participant system.	1. A computer implemented method for enabling perception of a personalization item in an instant messaging communications session, the method comprising: storing on a host system one or more personalization items associated with an instant messaging application operator; receiving a request from an instant messaging participant system for the personalization items associated with the instant messaging application operator; accessing the personalization items at the host system; and communicating the personalization items from the host system to the instant messaging participant system for rendering in an instant messaging application running on the instant messaging participant system.
2. The method of claim 1 in which receiving the request comprises receiving a request for a video clip selected by an instant message sender.	

3. The method of claim 1 in which receiving the request comprises receiving a request that is generated in response to a communication from an instant messaging sender system to the instant messaging participant system.	
4. The method of claim 1 in which receiving the request comprises receiving an identifier enabling identification of the selected video clip.	2. The method of claim 1 in which the receiving the request comprises: receiving an identifier enabling identification of a personalization item associated with the instant messaging application operator.
5. The method of claim 4 in which receiving the identifier further comprises receiving an identifier comprising a location on the host system of the selected video clip.	4. The method of claim 2 in which receiving the identifier further comprises receiving an identifier comprising a location on the host system of the personalization item.
6. The method of claim 5 in which the identifier further comprises a file name.	
7. The method of claim 4 wherein receiving the identifier comprises receiving an identifier created for the selected video clip based upon the application of an algorithm to at least a portion of the selected video clip.	19. The method of claim 1 further comprising creating an identifier for a personalization item based upon the application of an algorithm to at least a portion of data comprising the item.
8. The method of claim 4 in which receiving the identifier comprises receiving the identifier in response to a communication from an instant messaging sender system to the instant messaging participant system.	
9. The method of claim 1 in which the host comprises a server authorized as a partner to an instant messaging host.	7. The method of claim 1 in which the host comprises a server authorized as a partner to an instant messaging host.
10. The method of claim 1 in which storing the video clips comprises storing one or more still photographs and a sound track.	13. The method of claim 1 in which storing the personalization items comprises storing a video segment.
11. The method of claim 1 in which storing the video clips comprises storing an animation sequence.	12. The method of claim 1 in which storing the personalization items comprises storing an animation sequence.
12. The method of claim 1 in which storing the video clips comprises storing one or more video clips configured to expire upon the occurrence of a predetermined event.	14. The method of claim 1 in which in which storing the personalization items comprises storing a personalization item configured to expire upon the occurrence

	of a predetermined event.
13. The method of claim 12 in which the predetermined event comprises passage of a predetermined length of time or the passage of a predetermined date.	15. The method of claim 14 in which the predetermined event comprises passage of a predetermined length of time or the passage of a predetermined date.
14. The method of claim 12 in which the predetermined event comprises a predetermined number of uses.	16. The method of claim 14 in which the predetermined event comprises a predetermined number of uses.
15. The method of claim 12 further comprising: determining whether the video clip has expired, and disallowing access to the video clip if the video clip has expired.	17. The method of claim 14 further comprising: determining whether the personalization item has expired, and disallowing access to the personalization item if the personalization item has expired
16. The method of claim 1 further comprising: determining whether the video clip has been banned, and disallowing access to the video clip if the video clip has been banned.	18. The method of claim 1 further comprising: determining whether the personalization item has been banned, and disallowing access to the personalization item if the personalization item has been banned.
17. The method of claim 16 in which determining whether the video clip has been banned comprises determining whether the video clip has been banned based on a report by a user.	
18. The method of claim 16 in which determining whether the video clip has been banned comprises determining whether the video clip has been banned based on a violation of a term of a service agreement.	
19. The method of claim 1 further comprising determining whether the selected video clip is an official item; and displaying the selected video clip if the video clip is an official item.	21. The method of claim 20 further comprising determining whether the personalization item is an official item based upon the identifier; and displaying the personalization item if the personalization item is an official item.

This is a provisional obviousness-type double patenting rejection because the conflicting claims have not in fact been patented.

Claim Objections

Claims 23-25 are objected to because there is no antecedent basis for "determining capabilities". The examiner believes that claims 23-25 were intended to depend on claim 22 instead of claim 20. For the purpose of expediting prosecution of this application, the examiner will interpret claims 23-25 as depending on claim 22 instead of claim 20. Appropriate correction is required.

Claim Rejections - 35 USC § 101

35 U.S.C. 101 reads as follows:

> Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

Claims 27-52 are rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter. Claims 27-52 recite a computer program stored on a computer readable medium. The specification states that the computer readable medium comprises a propagated signal (see specification page 4, lines 2-4), which is non-statutory according to MPEP 2106. A propagated signal does not fall under any of the statutory categories of invention provided by 35 U.S.C. 101 because it is not a new and useful process, machine, manufacture, or composition of matter.

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claims 1-6, 8, 10-11, 19-21, 26-32, 34, 36-37, 45-47, and 52 are rejected under 35 U.S.C. 102(b) as being anticipated by the MusicCity (now StreamCast) Morpheus software program, version 1.9 (hereinafter **Morpheus**). The Archive.org archived copy of the MusicCity Morpheus download page on c|net Download.com dating from October 8, 2001 and retrieved from <URL: http://web.archive.org/web/20011008191757/download.cnet.com/downloads/0-1896420-100-5590701.html> (hereinafter **Download.com**) provides a description of the software.

Regarding claim 1, Morpheus teaches a computer implemented method for enabling perception of a video clip in an instant messaging communications session, the method comprising:

- Storing on a host system one or more video clips
- Receiving a request at the host system for a selected video clip to be delivered to an instant messaging participant system
- Accessing the selected video clip stored at the host system
- Communicating the selected video clip from the host system to the instant messaging participant system for rendering in an instant messaging application running on the instant messaging participant system

(see Download.com, page 1)

Morpheus provides instant messaging, so it can therefore be considered as an instant messaging participant system. Furthermore, Morpheus allows users to search for, download, and view video clips via its embedded media player. Because Morpheus is a P2P file-sharing application, it allows any system running the software to act as a host system to deliver video clips.

Regarding claim 2, Morpheus teaches that the receiving the request comprises receiving a request for a video clip selected by an instant message sender (see Download.com, page 1). Morpheus is a file-sharing application that allows any user to request a file, such as a video clip, to download and view.

Regarding claim 3, Morpheus teaches that receiving the request comprises receiving a request that is generated in response to a communication from an instant messaging sender system to the instant messaging participant system. It is inherent that Morpheus must receive a request that is generated in response to a communication from an instant messaging sender system to the instant messaging participant system in order to initiate a download of a video clip.

Regarding claim 4, Morpheus teaches that the receiving the request comprises receiving an identifier enabling identification of the selected video clip (see Download.com, page 1). It is inherent that Morpheus must receive an identifier enabling identification of the selected video clip in order to determine which video clip was requested.

Regarding claim 5, Morpheus teaches that the receiving the identifier further comprises receiving an identifier comprising a location on the host system of the

selected video clip. It is inherent that the Morpheus application must know the location of the file that was requested in order to deliver it to the requesting user.

Regarding claim 6, Morpheus teaches that the identifier further comprises a file name. It is inherent that the Morpheus application must know the location of the file that was requested in order to deliver it to the requesting user.

Regarding claim 8, it is inherent in the Morpheus application that receiving the identifier comprises receiving the identifier in response to a communication from an instant messaging sender system to the instant messaging participant system.

Regarding claim 10, Morpheus teaches that storing the video clips comprises storing one or more still photographs and a sound track. A video clip is the same as one or more still photographs and a sound track. Therefore, this claim does not recite any additional limitations.

Regarding claim 11, Morpheus teaches that storing the video clips comprises storing an animation sequence. A video clip can also be reasonably interpreted as being the same as an animation sequence. Therefore, this claim does not recite any additional limitation.

Regarding claim 19, Morpheus teaches a method further comprising determining whether the selected video clip is an official item; and displaying the selected video clip if the video clip is an official item. The specification is silent as to how to differentiate an "official item" from a regular item. Therefore, this dependent claim is not patentably distinct from its parent claim and does not recite any additional limitations.

Claims 20-21 recite significantly the same limitations as claim 1 and are therefore rejected under the same rationale.

Regarding claim 26, Morpheus teaches a computer implemented method for enabling perception of a video clip in an instant messaging communications session, the method comprising:

- Rendering, on an instant messaging recipient system, an instant messaging application user interface for an instant messaging communications session involving at least an instant message recipient and an instant message sender;
- Receiving a message that includes a video clip identifier corresponding to a selected video clip to be displayed by the instant messaging recipient system, the video clip being selected by the instant message sender at an instant messaging sender system;
- Automatically accessing the selected video clip based on the video clip identifier; and
- Rendering the selected video clip at the instant messaging recipient system

(see Download.com, page 1)

Claims 27-32, 34, 36-37, and 45-47 recite a computer program with significantly the same limitations as claims 1-6, 8, 10-11, and 19-21 (respectively) rejected above. Therefore, they are rejected under the same rationale.

Claim 52 recites a computer program with significantly the same limitations as claim 26. Therefore, claim 52 is rejected under the same rationale.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

Claims 7 and 33 are rejected under 35 U.S.C. 103(a) as being unpatentable over Morpheus in view of Van Hoff et al. (hereinafter Van Hoff), United States Patent number 5,919,247.

Morpheus teaches all the elements of claim 7 except that receiving the identifier comprises receiving an identifier created for the selected video clip based upon the application of an algorithm to at least a portion of the selected video clip. This is the same as using a cryptographic hash algorithm such as Message-Digest Algorithm 5 (MD5) to verify the identity of a file, which was a well known method to persons of ordinary skill in the art at the time the invention was made (see Van Hoff column 6 lines 14-21). It would have been obvious to one of ordinary skill in the art at the time the invention was made to combine the cryptographic hash algorithm method taught by Van Hoff with the method of Morpheus in order to verify the identities of requested video clips.

Claim 33 recites a computer program with significantly the same limitations as claim 7. Therefore, claim 33 are rejected under the same rationale.

Claims 9 and 35 are rejected under 35 U.S.C. 103(a) as being unpatentable over Morpheus in view of Routtenberg et al. (hereinafter Routtenberg), United States Patent Application Publication 2002/0049717.

Morpheus teaches all the elements of claim 9 except for the host comprising a server authorized as a partner to an instant messaging host. This is the same as centralized peer-to-peer file sharing, whereas Morpheus using de-centralized peer-to-peer file sharing. Centralized peer-to-peer file sharing was well known in the art at the time the invention was made, as evidenced in Routtenberg (see Routtenberg paragraph [0010]). It would have been obvious to one of ordinary skill in the art at the time the invention was made to combine the centralized peer-to-peer file sharing as taught by Routtenberg with the method of Morpheus as an alternate design choice for file sharing.

Claim 35 recites a computer program with significantly the same limitations as claim 9. Therefore, claim 35 is rejected under the same rationale.

Claims 12-15 and 38-41 are rejected under 35 U.S.C. 103(a) as being unpatentable over Morpheus in view of Snyder et al. (hereinafter Snyder), United States Patent number 6,070,171.

Regarding claims 12-15, Morpheus teaches all the elements of claims 12-15 except that storing the video clips comprises storing one or more video clips configured to expire upon the occurrence of a predetermined event, such as passage of a predetermined length of time, the passage of a predetermined date, or a predetermined number of uses, then disallowing access to the video clip if the video clip was determined to have expired. Snyder teaches an invention that can limit the duration of

use and/or the number of uses of data (see column 12 lines 44-49). It would have been obvious to one of ordinary skill in the art at the time the invention was made to combine the limiting the duration of use and/or the number of uses of data taught by Snyder with the invention of Morpheus in order to provide digital rights management capabilities for the downloaded files.

Claims 38-41 recite a computer program with significantly the same limitations as claims 12-15. Therefore, they are rejected under the same rationale.

Claims 16-18 and 42-44 are rejected under 35 U.S.C. 103(a) as being unpatentable over Morpheus in view of Tessman, Jr. et al. (hereinafter Tessman), United States Patent number 7,120,687.

Regarding claims 16-18, Morpheus teaches all the elements of claims 16-18 except for the determining whether the video clip has been banned based on a report by a user or on a violation of a term of service agreement, and disallowing access to the video clip if the video clip has been banned. Tessman teaches an equivalent method for use with images instead of video clips. Tessman teaches determining whether an image has been banned based on a report by a user (see column 19 lines 10-24) or on a violation of a term of service agreement, and disallowing access to the image if the image has been banned (see column 22 lines 48-67). It would have been obvious to one of ordinary skill in the art at the time the invention was made to combine the method of Tessman with the invention of Morpheus in order to manage offensive content.

Claims 42-44 recite a computer program with significantly the same limitations as claims 16-18. Therefore, they are rejected under the same rationale.

Claims 22-25 and 48-51 are rejected under 35 U.S.C. 103(a) as being unpatentable over Morpheus in view of Video: An empirical study of realvideo performance across the internet, from Proceedings of the 1st ACM SIGCOMM Workshop on Internet Measurement IMW '01, by Yubing Wang, Mark Claypool, and Zheng Zuo (hereinafter Wang).

Morpheus teaches all the limitations of claims 22-25 except for determining capabilities of the instant messaging participant at the host system by determining a data connection speed, identifying hardware associated with the instant messaging participant system, and identifying software associated with the instant messaging participant system, then determining an appropriate version from one or more versions of the selected video clip based upon the determined capabilities and accessing the appropriate version of the selected video clip. Wang teaches determining capabilities of the instant messaging participant at the host system by determining a data connection speed, identifying hardware associated with the instant messaging participant system, and identifying software associated with the instant messaging participant system (see page 298 paragraph 2), then determining an appropriate version from one or more versions of the selected video clip based upon the determined capabilities and accessing the appropriate version of the selected video clip (see page 297, Bandwidth Characteristics section). It would have been obvious to one of ordinary skill in the art at the time the invention was made to combine the methods taught by Wang with the invention taught by Morpheus in order to provide video clips that are appropriate for each user's system.

Claims 48-51 recite a computer program with significantly the same limitations as claims 22-25. Therefore, they are rejected under the same rationale.

Conclusion

The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

- Mariano, Gwendolyn. ZDNet News. "Morpheus 1.9 to be unleashed". [online] June 10, 2002 [accessed February 14, 2007], Retrieved from Internet <URL: http://news.zdnet.com/2100-3513_22-934615.html>.
- Pruitt, Scarlet. IDG News Service. "Morpheus Updates Peer-to-Peer Client" [online] June 10, 2002 [accessed February 14, 2007], Retrieved from Internet <URL: http://www.pcworld.com/article/id,101736/article.html>.
- Archive.org archived copy of the Morpheus 1.9.1 download page on c|net Download.com [online] August 3, 2002 [accessed February 14, 2007], Retrieved from Internet <URL: http://web.archive.org/web/20020803071751/download.com.com/3000-2166-10057840.html>.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Stephen Alvesteffer whose telephone number is (571) 270-1295. The examiner can normally be reached on Monday-Friday 10:30AM-7:00PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, John Cabeca can be reached on (571)272-4048. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see http://pair-direct.uspto.gov. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

3-5-2007

Stephen Alvesteffer
Examiner
Art Unit 2173

RAYMOND J. BAYERL
PRIMARY EXAMINER
ART UNIT 2173